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Customer No. 30223 **PATENT**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appl. No.	:	10/748,770
Applicant	:	Peter Anderson et al.
Filed	:	December 29, 2003
Title	:	Gaming Machine With Sorting Feature
TC/A.U.	:	3713
Examiner	:	Peter Anderson *et al.*
Docket No.	:	47079-00055USC2

TRANSMITTAL OF APPEAL BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to the Commissioner for Patents, Mail Stop Appeal Brief - Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on October 3, 2005.

Signature: _____
Adrienne White

Submitted herewith is Appellants' Appeal Brief (in triplicate) in support of the Notice of Appeal filed August 15, 2005. A check in the amount of $500.00 is enclosed for the fee associated with filing this Appeal Brief in accord with 37 C.F.R. § 41.20. To the extent necessary, please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 10-0447 (Attorney Docket No. 47079-00055USC2) and please credit any additional fees to such deposit account.

Date: October 3, 2005

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APPEAL BRIEF PURSUANT TO 37 C.F.R. § 41.37

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Commissioner:

This appeal brief is filed pursuant to Appellant's appeal to the Board of Patent Appeals and Interferences from the final rejection of claims 30-49 and 51 in an Office Action dated March 14, 2005, for the above-listed application.

1. REAL PARTY IN INTEREST

The real party in interest is WMS Gaming Inc., a corporation organized and existing under the laws of the State of Delaware, having its principal place of business at 800 South Northpoint Boulevard, Waukegan, IL 60085

2. RELATED APPEALS AND INTERFERENCES

There are no related appeals and interferences.

3. STATUS OF CLAIMS

Claims 30-49 and 51 have been finally rejected. Claim 50 was objected to as depending from a rejected base claim, but was indicated to contain allowable subject matter.

It is from the final rejection of claims 30-49 and 51 that this appeal is taken.

4. STATUS OF AMENDMENTS

No Amendment has been submitted subsequent to the imposition of the Final Office Action dated March 14, 2005. A Request for Reconsideration was submitted on June 14, 2005, and was considered by the Examiner as evidenced by the Advisory Action dated July 15, 2005.

5. SUMMARY OF CLAIMED SUBJECT MATTER

The present invention relates to a gaming machine which includes a sorting feature, in which a collection of scrambled objects, such as letters, symbols, pictures, or puzzle pieces, are sorted to some extent (*see*, *e.g.*, page 1, lines 2-5). The present invention is directed, in one aspect, to a gaming machine (10; Fig. 1) including at least one display (*e.g.*, 13; FIG. 1) displaying a plurality of groups of objects (*see, e.g.*, FIG. 13; page 10, lines 6-15; *see also* FIGS. 16, 18) and a plurality of player-selectable elements (*see, e.g.*, FIG. 14; page 10, lines 6-15; *see also* FIGS. 15, 17) separate from the plurality of groups of objects. Each of the plurality of player-selectable elements is simultaneously displayed (*see, e.g.*, FIG. 14) and initially conceals

indicia (*compare, e.g.*, FIG. 14 *with* FIGS. 15, 17). These indicia are indicative of all of the objects within the plurality of groups of objects (*see, e.g.*, FIGS. 17-18; page 10, lines 14-18).

An input device (*e.g.*, 17; FIG. 2; page 5, lines 9-11) for receiving from a player sequential selections of the simultaneously displayed player-selectable elements (*see, e.g.*, page 10, lines 13-31; FIGS. 13-18). A processor (16; FIG. 2) is provided in communication with the display (*e.g.*, 13; FIG. 2) and the input device (*e.g.*, 17; FIG. 2). In response to each of the selections received from the input device (17), the processor (16) instructs the display (*e.g.*, 13; *see also* FIGS 14-15) to reveal each of the objects associated with the selected one of the plurality of the player-selectable elements (*see, e.g.*, page 10, lines 16-31). The processor (16) renders the selected one of the plurality of the player-selectable elements subsequently un-selectable (*compare, e.g.*, FIGS. 15 *and* 17; *see also* page 10, lines 14-15). The processor (16) is further configured to award a payout associated with one of the plurality of groups whose objects have all been revealed (*see, e.g.*, page 10, lines 25-28).

In at least some embodiments (see, e.g., claims 34, 44), a touch screen may be utilized to accept player inputs of selected ones of the plurality of player-selectable elements (see, e.g., page 4, lines 26-27; page 9, line 26)

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

I. Claims 30-33, 35-43, 45-48 and 51 stand finally rejected under 35 U.S.C. §102(b) as being anticipated by Helm et al. (U.S. Pat. No. 4,743,024) (hereinafter "Helm").

II. Claims 34, 36, 44, 46 and 49 stand finally rejected under 35 U.S.C. §103 for obviousness predicated upon Helm.

7. ARGUMENT

I. THE 35 U.S.C. § 102 REJECTION OF CLAIMS 30-33, 35-43, 45-48 AND 51

Claims 30-33, 35-43, 45-48 and 51 are being rejected under 35 U.S.C. § 102(b) as being anticipated by Helm et al. (U.S. 4,743,024). Appellant contends that this rejection is improper and should be reversed.

A. EQUIVALENTS ARGUMENTS IMPROPER WITHIN 35 U.S.C. § 102 ANALYSIS

In numbered paragraph 3 of the Final Office Action and the Advisory Action dated July 24, 2005, the Examiner takes the position that Helm's "teaching of a player selectable elements is equivalent to the player selectable elements of the instant invention" and argues, in support of this position that, in Helm, "the player selectable elements are selected by a player selecting the 'skill stop' buttons 26, 28 and 30 on the gaming machine to stop the reels as shown in Figure 1 to select the letters/numbers to be associated with a bingo card." The Examiner concludes and alleges that, "[l]ike the instant invention, Helm's player 'skill stop' selection element is also considered a random selection and therefore performs the same function as the player selectable elements in the instant invention." The Examiner bases equivalency to a test of whether or not the alleged equivalent "performs the same function".

Appellant respectfully submits to this honorable Board that a *prima facie* case of anticipation under 35 U.S.C. § 102 requires the Examiner to show that the asserted reference, here Helm, discloses, either expressly or inherently, each and every element as set forth in the claim. *See, e.g., Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Stated differently, it is respectfully submitted that anticipation requires that "[t]he identical invention must be shown in as complete detail as is contained in the

... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Appellant respectfully submits that the Examiner's reasoning and conclusion are legally erroneous. Appellant submits that the Examiner is improperly relying on equivalence as a rationale supporting an anticipation rejection under 35 U.S.C. § 102 in claims that do not invoke 35 U.S.C. § 112, paragraph 6. "[A]nticipation under § 102 can be found only when the reference discloses exactly what is claimed and that where there are differences between the reference disclosure and the claim, the rejection must be based on § 103 which takes differences into account." *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). Appellant respectfully submits that the Examiner's reliance on equivalents constitutes an admission by the Examiner that Helm does not disclose exactly what is claimed. Accordingly, Appellant respectfully submits that the alleged *prima facie* case of anticipation of each of claims 30-33, 35-43, 45-48 and 51 under 35 U.S.C. § 102 is factually and legally improper and should be reversed.

Even within the context of a *prima facie* rejection for obviousness, it is respectfully submitted that "[i]n order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency *must be recognized in the prior art*, and cannot be based on applicant's disclosure or the mere fact that the components at issue are functional or mechanical equivalents". *In re Ruff*, 256 F.2d 590, 118 USPQ 340 (CCPA 1958). The Examiner has not shown *evidence* of the asserted "equivalency," nor did the Examiner show the alleged differences between the two deemed to be insubstantial if the element in the accused device "performs substantially the same function in substantially the same way to obtain the same result" as the

claim limitation. *See Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 608 (1950). Although Appellant disagrees with the Examiner and takes the position that Helm's "skill stop" selection element 26, 28, 30 does not perform the same function as the player selectable elements in the instant invention, as further elaborated upon herein, Appellant submits that the Examiner has failed to set forth any evidence that Helm's "skill stop" selection elements 26, 28, 30 performs substantially the same function *in substantially the same way to obtain the same result* as the claim limitation. Thus, even if this Board did not deem improper the Examiner's importation of the doctrine of equivalency into a 35 U.S.C. § 102 anticipation analysis that does not invoke 35 U.S.C. § 112, paragraph 6, the Examiner has failed to set forth a *prima facie* case of anticipation. Broad conclusory statements, standing alone, are not "evidence". *McElmurry v. Arkansas Power & Light Co.*, 995 F.2d 1576, 1578 (Fed. Cir. 1993).

B. HELM DOES NOT IDENTICALLY TEACH EACH AND EVERY ELEMENT OF CLAIMS 30-33 AND 35-39

Claims 30-33 and 35-39 recite "a processor in communication with said display and said input device, in response to each of said selections received from said input device, said central processing unit processor instructing said display to reveal each of said objects associated with said selected one of said plurality of said player-selectable elements, *said processor rendering said selected one of said plurality of said player-selectable elements subsequently un-selectable*".

The Examiner alleges that Helm identically teaches this element (*citing* Abstract; Col. 1, line 46 – Col. 2, line 8; and Col. 4, lines 55-62), while defining Helms' reels 22, 24 as "player-selectable elements" (*see* numbered paragraph 3 of page 2 of Office Action).

The cited portions of Helms merely state that when the player pulls the handle 16, the reels 22, 24 spin in a conventional fashion until they stop at a random spot (*i.e.*, Helm characterizes reels 22, 24 as "random number display means" (col. 2, line 11) and "random display reels 22 and 24" (col. 5, line 2), as noted above). The number displayed by reels 22, 24 is then illuminated in the display matrix 15 (col. 4, lines 58-59).

The Examiner further alleges Helm teaches "at least one display displaying a plurality of objects (15, the display is comprises of a number of groups of objects . . .) and a plurality of selectable elements (22, 24) separate from the groups of objects (15) each of said plurality of player-selectable elements being simultaneously displayed and initially concealing indicia indicative of all of said objects within said plurality of groups of objects" (*see* Final Office Action, page 3, paragraph 1). According to the Examiner, "[e]ach of the plurality of player-selectable elements are initially concealed in that the player is unaware of what symbols are going to appear on respective reels (22)(24) until after the player spins." *Id.*

Helm explicitly states that "an operation of the machine comprises seven numerical displays of the drums, *and in such seven displays the same numbers may be displayed twice or more by the random display means by* [sic: but] *of course the said number can only be illuminated once and display of the same number twice means of loss of a turn to the player.*" (col. 2, lines 39-43)(emphasis added).

Thus, contrary to the Examiner's assertion, Helm does not and cannot comprise a processor that renders "*said selected one of said plurality of said player-selectable elements subsequently un-selectable*". Even accepting *arguendo* the Examiner's assertion that the claimed player-selection elements are read upon by the random numbers displayed on the reels 22, 24 of

Helm, the fact that the same numbers may be displayed on the random display means (*i.e.*, reels 22, 24) "twice or more" absolutely precludes any logical assertion that Helm teaches the claimed processor which renders a selected one of the plurality of player-selectable elements subsequently un-selectable. In other words, Helm does not teach (or suggest) that the player-selectable elements are rendered subsequently un-selectable. If that were the case, which it is not, then an initial random outcome of "2 2" in Helm would preclude the number "2" from appearing in either reel 22 or 24. Consequently, the reel positions corresponding to "1 2", "2 1", "2 3", "2 4", "2 5", "3 2", "4 2", and "5 2" would then be un-selectable. This clearly would be unsuitable for Helm's bingo-game having a 5x5 matrix. Appellant respectfully submits that Helms expressly teaches that the same number may occur *twice or more* (on one or both reels) and establishes that the player-selectable elements (*i.e.*, the random number means 22, 24, as asserted by the Examiner) are not rendered "subsequently un-selectable."

Appellant respectfully submits that Helm fails to identically teach at least this aspect of claims 30 and 33, 35-39 and fails to anticipate these claims under 35 U.S.C. § 102. Reversal of the Examiner's rejection is requested for at least this reason.

C. HELM DOES NOT IDENTICALLY TEACH EACH AND EVERY ELEMENT OF CLAIMS 40, 43 AND 45-48

The Examiner asserts Helm allegedly teaches "a plurality of selectable objects (22, 24) separate from the groups of objects (15), each of said plurality of player-selectable objects being simultaneously displayed and initially concealing indicia indicative of all of said objects within said plurality of groups of objects" (*see* numbered paragraph 3 of Office Action). The Examiner contends that "[e]ach of the plurality of player-selectable elements are initially concealed in that

the player is unaware of what symbols are going to appear on respective reels (22)(24) until after the player spins". *Id.*

Helm does not teach a plurality of player-selectable elements simultaneously displayed in an array, "said plurality of player-selectable elements initially concealing indicia indicative of said objects within said plurality of groups of objects, at least some of said plurality of selectable elements concealing indicia that can be indicative of any object within any of said plurality of groups," as recited by claims 40, 43, and 45-48. When buttons 26, 28 are configured to function as "skill stop" buttons, as described in col. 5, lines 30-42 in Helm, the reels 22, 24 do not "conceal" indicia that can be indicative of any object within any of said plurality of groups. In other words, the random outcome is not "initially concealed" and then subsequently "revealed," as claimed (*i.e.*, "said plurality of player-selectable elements initially concealing indicia indicative of said objects . . . and a processor . . . said processor instructing said display to reveal each of said objects associated with said selected one of said plurality of said player-selected elements"). Instead, in the "skill stop" embodiment of Helm, the random outcome is generated and revealed simultaneously.

Helm thus fails to identically teach each and every aspect of claims 40 and 43, 45-48 and fails to anticipate these claims under 35 U.S.C. § 102. Reconsideration and withdrawal of this rejection is requested for at least the above reasons.

D. HELM DOES NOT IDENTICALLY TEACH EACH AND EVERY ELEMENT OF CLAIM 51

Claim 51 recites "a processor in communication with said display and said input device, in response to each of said sequential selections received from said input device, *said processor*

instructing said display . . . to remove said selected one of said plurality of said player-selectable elements from a population of player-selectable elements to prevent subsequent selection of said selected one of said plurality of said player-selectable elements".

Assuming hypothetically, *arguendo*, that the "player selectable elements" correspond to Helm's reels 22, 24, as is alleged by the Examiner, the claimed instructions by the processor to "remove said selected one of said plurality of said player-selectable elements from a population of player-selectable elements to prevent subsequent selection of said selected one of said plurality of said player-selectable elements" would, in Helm, permit the player of the gaming machine to make only a *single* "skill stop". In other words, a player pressing buttons 26, 28 to stop the motion of corresponding reels 22, 24, would cause the removal of the reels 22, 24 from the population of player-selectable elements to prevent subsequent selection of the reels 22, 24. In a bingo-game, such as in Helm, wherein a player is seeking to obtain five aligned outcomes on a display, limiting the player to a single outcome would surely not be conducive to repeat game play.

Even if the Examiner were to attempt to argue that the reels 22, 24 were not the player selectable elements, but rather that the indicia thereupon were the player selectable elements, as is suggested by some of the Examiner's statements, the Examiner's argument still must fail. Helm permits the same numbers to be displayed on the random display means (*i.e.*, reels 22, 24) "twice or more" (*see*, *e.g.*, col. 2, lines 40-42). In a hypothetical example wherein the indicia or numbers on each of reels 22, 24 were asserted to correspond to the "player selectable elements," Helm does not teach or suggest that the such indicia or numbers are, subsequent to display, were removed from a population of available numbers. If that were the case, then an initial random

outcome of "2 2" would then remove the number "2" the population of available numbers appearing in either reel 22 or 24. Consequently, the reel positions corresponding to "1 2", "2 1", "2 3", "2 4", "2 5", "3 2", "4 2", and "5 2" would then be un-selectable, which would render a bingo-type game unsuitable for its intended purpose. Accordingly, Helms' express teaching that the same number may occur twice or more (on one or both reels) establishes that the displayed indicia or outcomes provided on the reels 22, 24, would not be removed, in this hypothetical, from a population of "player-selectable elements" to prevent subsequent selection of the displayed one of the "player-selectable elements".

Helm thus fails to identically teach each and every aspect of claim 51 and fails to anticipate claim 51 under 35 U.S.C. § 102. Reconsideration and withdrawal of this rejection is requested for at least the above reasons.

II. THE 35 U.S.C. § 103 REJECTION OF CLAIMS 34, 36, 44, 46 AND 49

Claims 34, 36, 44, 46 and 49 were finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Helm. Reversal of this rejection is respectfully requested.

A. OBVIOUSNESS REJECTION OF CLAIMS 34 AND 44 UNDER 35 U.S.C. § 103 IN VIEW OF HELM IS IMPROPER

With respect to claim 34, the Examiner acknowledged that Helm does not teach a touch screen. To make up for this deficiency, the Examiner alleges that it would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated into Helm the "*touch screen* to select elements" (claims 34, 44)(*see, e.g.*, page 4, numbered paragraph 5 of Final Office Action). According to the Examiner, "[d]oing so provides an alternative method (a

method well known to one having ordinary skill in the art) to Helm's 'reel spin' for randomly selecting a number or symbol corresponding to the matrix."

Appellant respectfully submits that the legal concept of *prima facie* obviousness allocates the burdens of going forward with production of evidence in each step of the examination process and assigns to the Examiner the initial burden of factually supporting any *prima facie* conclusion of obviousness. *See, e.g., In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999); *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352 (Fed. Cir. 1998). Appellant submits that the Examiner's burden to set forth a *prima facie* case of obviousness has not been discharged by the Examiner's broad conclusory statement that a touch screen provides an alternate method to Helm's "reel spin". *See, e.g., McElmurry v. Arkansas Power & Light Co.*, 995 F.2d 1576, 1578 (Fed. Cir. 1993). Appellant submits that, in order to rely on equivalence as a rationale supporting an obviousness rejection, the asserted equivalency between a touch screen and a button based reel spin/stop feature must be recognized in the prior art, and cannot be based on applicant's disclosure or the mere fact that the components at issue are or may be functional or mechanical equivalents. *See In re Ruff*, 256 F.2d 590, 118 USPQ 340 (CCPA 1958). The equivalency between a touch screen and buttons 26, 28 on a console or unit 21, which is itself separate from a primary rear display 14, must be recognized in the prior art. Such evidence has not been shown.

Appellant respectfully submits to this honorable Board that a gaming machine is not merely a reduction of its constituent parts. Each gaming machine has a "feel" which affects how players respond to the game and which influences each player's gaming experience and, in turn, the realization of the machine. Helm is a simple, mechanical-based machine providing a particularly selected interface between the player and the machine through lever 16 and buttons

26, 28. Helm provides a spinning reel arrangement consistent with the conventional spinning reel or "fruit" machines upon which Helm was attempting to improve (*see* col. 1, lines 13-40) and declares that the "spinning reel arrangement described herein provide a particularly advantageous machine . . ." (*see* col. 5, lines 62-64). The "feel" of Helm's gaming machine and/or game could be compromised by modification of the machine to remove the lever 16 and/or push-buttons 26, 28, which have a give and a tactile feel, with a glass-screen that accepts an input (*i.e.*, touch screen).

The Examiner has failed to demonstrate that these differences are insubstantial and Appellant respectfully submits that, although Helm may be modifiable in the manner proffered by the Examiner, a *prima facie* case of obviousness under 35 U.S.C. § 103 requires a suggestion or motivation in the reference or in the knowledge generally available to one of ordinary skill in the art. *See In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992). Moreover, Appellant respectfully submits that the level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308 (Fed. Cir. 1999). In this case, the Examiner's rejection is expressly premised upon this very basis (*i.e.*, the rejection is contingent upon the Examiner's mere assertion that incorporation into Helm of a touch screen to select elements "provides an alternative method (a method well known to one having ordinary skill in the art) to Helm's 'reel spin' for randomly selecting a number or symbol" (see page 5 of Final Office Action)). Accordingly, Appellant respectfully submits that such suggestion or motivation is lacking and the Examiner's *prima facie* case fails for want of the requisite legal and factual basis.

B. OBVIOUSNESS REJECTION OF CLAIMS 34 AND 36 UNDER 35 U.S.C. § 103 IN VIEW OF HELM IS IMPROPER

Appellant further submits that the Examiner has not set forth a *prima facie* case of obviousness as to independent claim 30, upon which claims 34 and 36 depend.

Still further, for the reasons stated above and in Section 7.I.B, which are not repeated herein for brevity, Helm explicitly teaches away from a gaming machine comprising a processor "rendering said selected one of said plurality of said player-selectable elements subsequently un-selectable". A prior art reference must be considered in its entirety, *i.e.*, as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Helm expressly teaches that "*the same numbers may be displayed twice or more by the random display means*" (col. 2, lines 39-43)(emphasis added), thus directly teaching away from the claimed recitation of rendering "said selected one of said plurality of said player-selectable elements subsequently un-selectable." As noted above, in the Bingo-type game of Helm, rendering the player-selectable elements subsequently un-selectable would render the Bingo-type game of Helm completely unsuitable for its intended purpose. "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984)(emphasis added).

Appellant respectfully requests this honorable Board to reversal this 35 U.S.C. § 103 rejection of claims 34 and 36 for at least the above reasons.

C. CLAIMS 44, 46, AND 49 ARE NOT OBVIOUS IN VIEW OF HELM

For the reasons stated above in Sections 7.I. and 7.II, which are not repeated in full herein for brevity, Appellant respectfully submits to this honorable Board that Helm fails to teach or suggest each and every element of independent claim 40, or claims 44 and 46 dependent thereupon, or of independent claim 49.

Further, Appellant submits that Helm does not teach or suggest a plurality of player-selectable elements simultaneously displayed in an array, said plurality of player-selectable elements "initially concealing indicia indicative of said objects within said plurality of groups of objects," required by each of claims 44, 46, and 49. As noted in the arguments above pertaining to claim 40, which arguments relate to each of claims 44, 46, and 49, Helm's buttons 26, 28 are configured to function as "skill stop" buttons (*see* col. 5, lines 30-42) and the reels 22, 24 do not "conceal" indicia that can be indicative of any object within any of said plurality of groups. In other words, the indicia of Helm indicating the random outcome are not "initially concealed" and then subsequently "revealed," as recited in independent claims 40 and 49. Helm teaches that a random outcome is revealed, in the "skill stop" embodiment, when the reels 22, 24 stop. Regarding the "skill stop" embodiment, Helm teaches that "the player . . . has some control over what number is displayed by each reel" (col. 5, lines 35-36) and Helm suggests that, in the asserted "skill stop" embodiment, the random outcome is generated and revealed simultaneously. In other words, the random outcome is responsive to an event initiated by the player's input and is not a random outcome that is initially "concealed" and then subsequently "revealed," as claimed.

Appellant respectfully submits that the Examiner has not set forth a *prima facie* case of obviousness as to claims 44, 46, and 49 in view of Helm for at least the above reason and requests reversal of the Examiner's 35 U.S.C. § 103 rejection of claims 44, 46, and 49.

8. CONCLUSION

Based upon the arguments submitted *supra*, Appellant respectfully submits that Helm does not identically describe the claimed invention within the meaning of 35 U.S.C. §102, either expressly or under the doctrine of inherency, and does not teach or suggest the claimed invention within the meaning of 35 U.S.C. § 103. Appellant, therefore, respectfully solicits the Honorable Board to reverse the Examiner's 35 U.S.C. § 102 rejection of claims 30-33, 35-43, 45-48 and 51 over Helm and 35 U.S.C. § 103 rejection of claims 34, 36, 44, 46 and 49 in view of Helm on at least the grounds noted above.

The fee of $500.00 required by 37 C.F.R. § 41.20 is enclosed herewith.

The Commissioner is hereby authorized to charge deposit account No. 10-0447/47079-00055USC2 for any additional fees inadvertently omitted which may be necessary now or during the pendency of this application, except for the issue fee.

October 3, 2005
Date

Respectfully submitted,

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9. APPENDIX OF CLAIMS

This listing of claims will replace all prior versions, and listing, of claims in the application.

1-29. (Cancelled)

30. (Previously Presented) A gaming machine, comprising:

at least one display displaying a plurality of groups of objects and a plurality of player-selectable elements separate from said plurality of groups of objects, each of said plurality of player-selectable elements being simultaneously displayed and initially concealing indicia indicative of all of said objects within said plurality of groups of objects;

an input device for receiving from a player sequential selections of said simultaneously displayed player-selectable elements; and

a processor in communication with said display and said input device, in response to each of said selections received from said input device, said processor instructing said display to reveal each of said objects associated with said selected one of said plurality of said player-selectable elements, said processor rendering said selected one of said plurality of said player-selectable elements subsequently un-selectable, and said processor awarding a payout associated with one of said plurality of groups whose objects have all been revealed.

31. (Previously Presented) The gaming machine of claim 30, wherein each of said plurality of player- selectable elements initially conceals indicia associated with one or more of said objects.

32. (Previously Presented) The gaming machine of claim 30, wherein said indicia includes a letter of the alphabet.

33. (Previously Presented) The gaming machine of claim 32, wherein said each of said objects is associated with a letter of the alphabet.

34. (Previously Presented) The gaming machine of claim 30, wherein said input device is a touch screen positioned over said display.

35. (Previously Presented) The gaming machine of claim 30, wherein each of said plurality of groups of objects is associated with a respective payout.

36. (Previously Presented) The gaming machine of claim 30, wherein said gaming machine conducts a basic game and a bonus game, said plurality of groups of objects and said plurality of player-selectable elements being associated with said bonus game.

37. (Previously Presented) The gaming machine of claim 30, wherein said indicia includes a letter of the alphabet and each of said groups of objects is a mixed group of letters of the alphabet that can be rearranged to form a word.

38. (Previously Presented) The gaming machine of claim 30, wherein said processor is located within said gaming machine.

39. (Previously Presented) The gaming machine of claim 30, wherein said at least one display includes two displays, one of said two displays for displaying said plurality of groups of objects, the other for displaying said plurality of player-selectable elements.

40. (Previously Presented) A gaming machine, comprising:

at least one display displaying a plurality of groups of objects and a plurality of player-selectable elements separate from said plurality of groups of objects, said plurality of player-selectable elements being simultaneously displayed in an array, said plurality of player-selectable elements initially concealing indicia indicative of said objects within said plurality of groups of objects, at least some of said plurality of selectable elements concealing indicia that can be indicative of any object within any of said plurality of groups;

an input device for receiving from a player sequential selections of said player-selectable elements from said displayed array of player-selectable elements; and

a processor in communication with said display and said input device, in response to each of said selections received from said input device, said processor instructing said display to reveal each of said objects associated with said selected one of said plurality of said player-selectable elements, said processor awarding a payout associated with one of said plurality of groups whose objects have all been revealed.

41. (Previously Presented) The gaming machine of claim 40, wherein each of said plurality of player-selectable elements initially conceals indicia associated with one or more of said objects.

42. (Previously Presented) The gaming machine of claim 40, wherein said indicia includes a letter of the alphabet.

43. (Previously Presented) The gaming machine of claim 42, wherein said each of said objects is associated with a letter of the alphabet.

44. (Previously Presented) The gaming machine of claim 40, wherein said input device is a touch screen positioned over said display.

45. (Previously Presented) The gaming machine of claim 40, wherein each of said plurality of groups of objects is associated with a respective payout.

46. (Previously Presented) The gaming machine of claim 40, wherein said gaming machine conducts a basic game and a bonus game, said plurality of groups of objects and said plurality of player-selectable elements being associated with said bonus game.

47. (Previously Presented) The gaming machine of claim 40, wherein said indicia includes a letter of the alphabet and each of said groups of objects is a mixed group of letters of the alphabet that can be rearranged to form a word.

48. (Previously Presented) The gaming machine of claim 40, wherein said at least one display includes two displays, one of said two displays for displaying said plurality of groups of objects, the other for displaying said plurality of player-selectable elements.

49. (Previously Presented) A gaming machine configured to conduct a basic game and a bonus game, comprising:

at least one display displaying, in said bonus game, a plurality of groups of objects and a plurality of player-selectable elements separate from said plurality of groups of objects, said

plurality of player-selectable elements being displayed in an array and initially concealing indicia indicative of said objects within said plurality of groups of objects;

an input device comprising a touch screen for receiving from a player sequential selections of said player-selectable elements from said displayed array of player-selectable elements; and

a processor in communication with said display and said input device, in response to each of said sequential selections received from said input device, said processor instructing said display to reveal each of said objects associated with said selected one of said plurality of said player-selectable elements, said processor awarding a payout associated with one of said plurality of groups whose objects have all been revealed,

wherein said touch screen is positioned over said display in an area where said array is being displayed.

50. (Previously Presented) A gaming machine configured to conduct a basic game and a bonus game, in accord with claim 49, wherein said bonus game comprises a pick-and-solve word puzzle.

51. (Previously Presented) A gaming machine configured to conduct a basic game and a bonus game, comprising:

at least one display displaying a plurality of groups of objects and a plurality of player-selectable elements separate from said plurality of groups of objects, said plurality of player-

selectable elements initially concealing indicia indicative of said objects within said plurality of groups of objects;

an input device for receiving from a player sequential selections of said player-selectable elements;

a processor in communication with said display and said input device, in response to each of said sequential selections received from said input device, said processor instructing said display to reveal each of said objects associated with said selected one of said plurality of said player-selectable elements and to remove said selected one of said plurality of said player-selectable elements from a population of player-selectable elements to prevent subsequent selection of said selected one of said plurality of said player-selectable elements, said processor awarding a payout associated with one of said plurality of groups whose objects have all been revealed.